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**REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP 2623
PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q60516

Masaru FUKU, et al.

Appln. No.: 09/650,629

Group Art Unit: 2623

Confirmation No.: 2240

Examiner: Vikkram BALI

Filed: August 28, 2000

For: VEHICLE KEY SYSTEM

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

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Commissioner for Patents
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Sir:

In response to the Office Action dated July 1, 2004, reconsideration and allowance of the subject application are respectfully requested. Upon entry of this Request, claims 1-6 and 8-12 are pending in the application. Applicant respectfully submits that the pending claims define patentable subject matter.

Claims 8-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the Examiner asserts that the limitation "the external unit" in the last line of claims 8-12 lacks an antecedent basis. However, Applicant respectfully submits that the rejection is improper since independent claim 8 recites "an external unit" at line 16. Accordingly, the Examiner is requested to remove the § 112, second paragraph, rejection.

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
U.S. Patent Application No. 09/650,629

Claims 1-6 and 8-12 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Daiss et al. (FR 2784066; hereafter “Daiss”) in view of cited Hsu et al. (USP 6,100,811; hereafter “Hsu”). Applicant respectfully submits that the claimed invention would not have been rendered obvious in view of the Examiner’s proposed combination of Daiss and Hsu.

Independent claim 1 recites, in part:

a manipulation detection means for detecting manipulations of at least one operation unit for controlling the pieces of equipment in the vehicle and at least one pedal, wherein said operation unit comprises at least one of a wiper switch, a turn signal switch, a shift lever, and a navigation unit for providing navigation services;

a fingerprint verification means for verifying an identity of the fingerprint information captured by said fingerprint information capturing means in a first processing mode by comparing the fingerprint information captured by said fingerprint information capturing means with the fingerprint information of the authorized user stored in said fingerprint information storage means, wherein the vehicle key system is configured to operate in the first processing mode and at least a second processing mode for administering storage of information in the fingerprint information storage means; and

a processing mode switching means for switching between the first and second processing modes according to detection of a predetermined manipulation of the at least one operation unit or the at least one pedal by said manipulation detection means.

In the April 13, 2004 Amendment, Applicant argued that the combination of Daiss and Hsu does not teach or suggest switching between first and second processing modes according to detection of a predetermined manipulation of the at least one operation unit or the at least one

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
U.S. Patent Application No. 09/650,629

pedal, wherein the operation unit comprises at least one of a wiper switch, a turn signal switch, a shift lever, and a navigation unit for providing navigation services, as required by claim 1.

In response to the arguments for patentability, the Examiner asserts that “[Daiss] discloses the manipulation detection means for detecting the manipulation of at least one operation unit and the operation unit being the shift lever (see page 6 line 23 through page 7 line 24, also figure 1, numerical 14 as being the shi[ft] lever, as being the operation unit and the sensing of the shift being the manipulation means) as claimed.” The Examiner further asserts that the references disclose switching between the first and the second mode because “Hsu in fingerprint actuation of customized vehicle features teaches the first processing mode and a second processing mode for administering storage of information of the fingerprint information storage means, (see col. 7, lines 27-48, the first mode being the one where the user / primary user have the fingerprint authorized before using the vehicle and the second mode being the enrollment mode) as claimed.”

However, Applicant respectfully submits that the cited references, alone or combined, do not disclose switching between a first processing mode for verifying captured fingerprint information and second processing modes for administering storage of fingerprint information according to detection of a predetermined manipulation of a pedal, a wiper switch, a turn signal switch, a shift lever, and/or a navigation unit, as required by claim 1. Daiss simply discloses (1) placing a vehicle electrical system into operation when a user's fingerprint information is verified and (2) starting the vehicle engine in response to a subsequent sequence of events by the user such as manipulation of a gear shift lever, the brake pedal and the accelerator pedal. Hsu

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
U.S. Patent Application No. 09/650,629

discloses (1) enabling operation of a vehicle in response to verification of a user's fingerprint information entered via a fingerprint sensor and (2) a user interface, such as a small display screen and a control panel, for selecting a mode of operation such as a first mode for enrolling new users and a second mode for fingerprint verification.

Thus, modifying the system of Daiss based on the teachings of Hsu would, at best, result in the addition of a user interface (i.e., display screen and control panel) for selecting a fingerprint verification or a user registration mode. Nowhere does Daiss or Hsu teach or suggest switching between these modes based on detection of a predetermined manipulation of a pedal, a wiper switch, a turn signal switch, a shift lever, and/or a navigation unit. Further, the Examiner's alleged motivation for combining the applied references (i.e., "they are analogous") does not include motivation for modifying the combined references so as to produce the claimed invention. In fact, since the combined references lack any teaching or suggestion of switching between a finger print verification mode and fingerprint registration/enrollment mode based on detection of a predetermined manipulation of a pedal, a wiper switch, a turn signal switch, a shift lever, and/or a navigation unit, no possible combination of the applied references could render the claimed invention obvious.

In rejecting claim 1, the Examiner simply alleges that "the modes as taught by ... Hsu's security system [could] easily be put into ... [Daiss'] system". While the system of the Daiss patent may be capable of being modified to operate as recited in claim 1, there must be a suggestion or motivation to do so. See *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
U.S. Patent Application No. 09/650,629

Examiner's analysis fails to identify where the suggestion to modify the combination can be found.

Accordingly, Applicant respectfully submits that independent claim 1, as well as dependent claims 2-6, should be allowable because the combined references do not teach or suggest all of the features of the claims, and one of ordinary skill in the art would not have been motivated to modify the teachings of the combined references to produce the claimed invention.

Applicant notes that the Examiner did not respond to the arguments for patentability set forth in the April 13 Amendment with regard to independent claim 8. That is, the "Response to Arguments" section of the Office Action only attempts to address the arguments for patentability with regard to claim 1. Nonetheless, as set forth in the April 13 Amendment, Applicant respectfully submits that claim 8 should be allowable because the combined references do not teach or suggest:

a connecting means for connecting said vehicle key system with an external unit and receiving a signal which indicates manipulation of the external unit; and

a processing mode switching means for switching between the first and second processing modes when the vehicle key system detects the signal received by the connections means indicating a predetermined manipulation of the external unit.

Although the Examiner does not cite any specific portion of Daiss or Hsu for disclosing the "connecting means" of claim 8, the Examiner alleges Daiss "discloses the external unit (see page 8, lines 4-6) as claimed." However, Daiss simply discloses that an additional fingerprint sensor may be provided on the exterior of the vehicle to allow entry of vehicle without allowing

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
U.S. Patent Application No. 09/650,629

the vehicle to be driven away (i.e., the vehicle may not be operated until authentication by the first fingerprint sensor provided in the vehicle interior is complete). Thus, the combination of Daiss and Hsu would simply result in a system having a first fingerprint sensor provided in the vehicle interior for allowing the vehicle to be operated, a second fingerprint sensor provided on the vehicle exterior for allowing the vehicle to be entered, and a user interface provided in the vehicle interior for switching between operation modes of the system. Nowhere do the combined references teach or suggest switching between first and second processing modes when the vehicle key system detects a signal received by a connections means indicating a predetermined manipulation of an external unit, as required by claim 8.

Accordingly, Applicant respectfully submits that independent claim 8, as well as dependent claims 9-12 should be allowable because the combined references do not teach or suggest all of the features of the claims, and one of ordinary skill in the art would not have been motivated to modify the teachings of the combined references to produce the claimed invention.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
U.S. Patent Application No. 09/650,629

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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